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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/718,642	11/24/2003	Ying Tat Leung	YOR920030362US1	1196
21254 7590 11/13/2008 MCGINN INTELLECTUAL PROPERTY LAW GROUP, PLLC 8321 OLD COURTHOUSE ROAD SUITE 200 VIENNA, VA 22182-3817				
EXAMINER				
DAM, KIM LYNN				
ART UNIT		PAPER NUMBER		
2179				
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11/13/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/718,642

Applicant(s)

LEUNG ET AL.

Examiner

KIM-LYNN DAM

Art Unit

2179

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 9/21/08 and 28 October 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-6,8-10,12-14 and 16-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-2, 4-6, 8-10, 12-14, and 16-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/28/08 has been entered.

Claims 1-2, 4-6, 8-10, 12-14, and 16-28 have been examined and are pending. Claims 1, 8, 22-25 and 28 are independent.

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 22 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claim 22 is directed to a signal-bearing medium tangibly embodying a program of machine-readable instructions. However, Applicant's disclosure (Page 16, line 13 to Page 17, line 4) defines "computer readable media" to include mediums which do not form the basic statutory subject matter under 35 U.S.C 101. Appropriate correction is required.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 23-27 are rejected under 35 U.S.C. 102(b) as being anticipated by Munyan (USPN 5,761,485).

Regarding claim 23, Munyan disclosed a portable computing device comprising:

a display (Column 6, lines 22-32; Figures 1-3);

a touch-sensitive display which is secondary and attached to the display (Column 6, lines 22-32; Figures 1-3),;

means for displaying a first of two adjoining display portions of a single display output in one of said display and said touch-sensitive display (Column 6, lines 22-32; Column 8, lines 35-57; Column 13, line 66 to Column 14, line 2; Figures 1-3);

means for displaying a second of said two adjoining display portions of said single display output in the other of said display and said touch-sensitive display (Column 6, lines 22-32; Column 8, lines 35-57; Column 13, line 66 to Column 14, line 2; Figures 1-3);

wherein said display and touch-sensitive display display said two adjoining portions as a single display output (Column 6, lines 22-32; Column 8, lines 35-57; Column 13, line 66 to Column 14, line 2; Figures 1-3).

Regarding claim 24, Munyan disclosed a method of providing a display for a portable computing device, the method comprising:

- providing a display (Column 6, lines 22-32; Figures 1-3); and

- providing a touch-sensitive display which is secondary and attachable to the first display (Column 6, lines 22-32; Figures 1-3);

- wherein said display and said touch-sensitive display display two adjoining display portions of a single display output (Column 6, lines 22-32; Column 8, lines 35-57; Column 13, line 66 to Column 14, line 2; Figures 1-3).

Regarding claim 25, Munyan disclosed a portable computing device comprising:

- a first display including a touch-sensitive user-interface (Column 6, lines 22-32; Figures 1-3); and

- a second display including another touch-sensitive user-interface attachable to the first display (Column 6, lines 22-32; Figures 1-3);

- wherein said first and second displays display two adjoining display portions of a single display output (Column 6, lines 22-32; Column 8, lines 35-57; Column 13, line 66 to Column 14, line 2; Figures 1-3), and

- wherein said first and second displays receive user input on each touch sensitive user- interface (Column 6, lines 22-32; Column 8, lines 35-57; Figures 1-3).

Regarding claim 26, Munyan disclosed the portable computing device of claim 4,

wherein said user-interface is configurable to one of: remove a key from the user-interface; change a label on a key on a user-interface; and change a color of a key on the user-interface (Column 12, lines 4-26; where various keyboard configurations, softkeys etc can be displayed).

Regarding claim 27, Munyan disclosed the method of claim 8, further comprising: displaying on said touch-sensitive display a user-interface that overlays a portion of said single display output (Column 5, lines 49-52; Column 8, lines 35-57; Column 13, line 66 to Column 14, line 2; Figures 1-2).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. **Claims 1-2, 4, 6-10, 12-14, 16-19 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Munyan (USPN 5,761,485) in view of Bogward (US 2004/0049743).**

Regarding claim 1, Munyan disclosed a portable computing device comprising:

a display (Column 6, lines 22-32; Figures 1-3); and

a second touch-sensitive display which is secondary and attachable to the display (Column 6, lines 22-32; Figures 1-3),

wherein said display and said touch-sensitive display display two adjoining display portions of a single display output (Column 6, lines 22-32; Column 8, lines 35-57; Column 13, line 66 to Column 14, line 2; Figures 1-3).

Munyan does not specifically disclose wherein only said touch-sensitive display is touch-sensitive. However, in an analogous art, Bogward disclosed an optional touch-screen (Figure 18). It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teachings of Bogward into Munyan to allow the option of having both displays be touch-sensitive or just one.

Regarding claim 2, the rejection of claim 1 is incorporated and further Munyan disclosed wherein the second touch-sensitive display is rotatably attachable to the display (Column 6, lines 22-32; Figures 1-3).

Regarding claim 4, Munyan the rejection of claim 1 is incorporated and further Munyan disclosed wherein said touch-sensitive display displays a user-interface that overlays a portion of said single display output (Column 5, lines 49-52; Column 8, lines 35-57; Column 13, line 66 to Column 14, line 2; Figures 1-2).

Regarding claim 6, Munyan the rejection of claim 4 is incorporated and further Munyan disclosed wherein the user-interface is reconfigurable in accordance with an instruction

from a software application being executed on the portable computing device (Column 7, lines 13-32; Column 8, lines 35-57).

Regarding claim 7, Munyan the rejection of claim 1 is incorporated and further Munyan disclosed wherein the display comprises a touch-sensitive display (Column 6, lines 22-32; Figures 1-3).

Regarding claim 8, Munyan disclosed a method of driving a portable computing device having a display attachable to a touch-sensitive display that is secondary and attachable to the display, the method comprising:

displaying a first of two adjoining display portions of a single display output in one of said display and said touch-sensitive display (Column 6, lines 22-32; Column 8, lines 35-57; Column 13, line 66 to Column 14, line 2; Figures 1-3);

displaying a second of said two adjoining display portions of said single display output in the other of said display and said touch-sensitive display (Column 6, lines 22-32; Column 8, lines 35-57; Column 13, line 66 to Column 14, line 2; Figures 1-3);

wherein said display and said touch sensitive display display said two adjoining display portions as a single display output (Column 6, lines 22-32; Column 8, lines 35-57; Column 13, line 66 to Column 14, line 2; Figures 1-3).

Munyan does not specifically disclose wherein only said touch-sensitive display is touch-sensitive. However, in an analogous art, Bogward disclosed an optional touch-screen (Figure 18). It would have been obvious to one of ordinary skill in the art at the

time the invention was made to incorporate the teachings of Bogward into Munyan to allow the option of having both displays be touch-sensitive or just one.

Regarding claim 9, the rejection of claim 8 is incorporate and further Munyan disclosed wherein the display is rotatably attachable to the touch-sensitive display (Column 6, lines 22-32; Figures 1-3).

Regarding claim 10, the rejection of claim 8 is incorporate and further Munyan disclosed wherein said touch-sensitive display further comprises displaying a user-interface comprising a keyboard (Column 9, lines 5-29; Column 12, lines 4-19).

Regarding claim 12, the rejection of claim 10 is incorporate and further Munyan disclosed reconfiguring the user-interface in response to an application state (Column 7, lines 13-32; Column 8, lines 35-57).

Regarding claim 13, the rejection of claim 12 is incorporate and further Munyan disclosed wherein reconfiguring the user-interface comprises reconfiguring the user-interface in response to a user preference (Column 7, lines 13-32; Column 8, lines 35-57).

Regarding claim 14, the rejection of claim 12 is incorporate and further Munyan disclosed wherein reconfiguring the user-interface comprises reconfiguring the user-

interface in response to a user instruction (Column 7, lines 13-32; Column 8, lines 35-57).

Regarding claim 16, the rejection of claim 8 is incorporate and further Munyan disclosed displaying a hot key that triggers the execution of a plurality of instructions in accordance with a state of the portable computing device (Column 12, lines 20-26; Column 14, lines 3-18).

Regarding claim 17, the rejection of claim 8 is incorporate and further Munyan disclosed displaying an application result (Column 6, lines 22-32; Column 8, lines 35-57; Figures 1-3).

Regarding claim 18, the rejection of claim 17 is incorporate and further Munyan disclosed wherein displaying an application result comprises displaying a first page of an electronic book on one of the display and the touch-sensitive display (Abstract; Column 6, lines 22-32; Column 8, lines 35-57; Figures 1-3).

Regarding claim 19, the rejection of claim 18 is incorporate and further Munyan disclosed wherein the displaying of the application result further comprises displaying a second page of an electronic book on the other one of the display and the touch-sensitive display (Abstract; Column 6, lines 22-32; Column 8, lines 35-57; Figures 1-3).

Regarding claim 22, it is the corresponding program product claim for method claim 8. Therefore, claim 22 is rejected under the same rationale as applied above.

Regarding claim 28, Munyan disclosed a portable computing device comprising:

- a display (Column 6, lines 22-32; Figures 1-3); and

- a touch-sensitive display which is secondary and attachable to the display (Column 6, lines 22-32; Figures 1-3);,

- wherein said display and said touch-sensitive display display two adjoining portions of a single display output (Column 6, lines 22-32; Column 8, lines 35-57; Column 13, line 66 to Column 14, line 2; Figures 1-3),

- wherein said touch-sensitive display displays a reconfigurable user interface (Column 7, lines 13-32; Column 8, lines 35-57) that overlays a portion of said single display output (Column 5, lines 49-52; Column 8, lines 35-57; Column 13, line 66 to Column 14, line 2; Figures 1-2).

Munyan does not specifically disclose wherein only said touch-sensitive display is touch-sensitive. However, in an analogous art, Bogward disclosed an optional touch-screen (Figure 18). It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teachings of Bogward into Munyan to allow the option of having both displays be touch-sensitive or just one.

6. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Munyan (USPN 5,761,485) in view of Bogward (US 2004/0049743), further in view of Liao (US 2004/0021681).

Regarding claim 5, the rejection of claim 1 is incorporated and further Munyan does not specifically disclose wherein the user-interface comprises a pointing device. However, in an analogous art, Liao disclosed the above limitation(Paragraph 0027, lines 9-14; Paragraph 0030, lines 19-24). It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teachings of Liao into the system of Munyan, since doing so would allow users to see their cursor position while touching the user interface as the user of Munyan would do (Liao, Paragraph 0027, lines 7-10)

7. Claim 20 is rejected under 35 U.S.C. 103(a) as being obvious over Munyan (USPN 5,761,485).

Regarding claim 20, Munyan did not expressly teach the method of claim 8, further comprising displaying a drop-down menu on the touch-sensitive display. However, Munyan disclosed various icons, windows, lists of items etc to be displayed (Column 12, lines 4-19). One of ordinary skill in the art at the time the invention was made would know that displaying a drop-down menu could be used in the same manner to display information/functions as disclosed by Munyan. It would have been obvious to one of

ordinary skill in the art at the time the invention was made to use drop-down menus as an easy way for users to navigate through information and functions.

8. Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Munyan (USPN 5,761,485) Munyan (USPN 5,761,485) in view of Bogward (US 2004/0049743), further in view of Stanek (USPN 5,936,554).

Regarding claim 21, the rejection of claim 8 is incorporated. Munyan did not specifically disclose the method of claim 10, wherein displaying the user-interface comprises displaying a color-coded keyboard. However, in an analogous art, Stanek disclosed the above limitation (Column 2, lines 5-8). It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teachings of Stanek in order to allow users to more easily discern keys and makes a keyboard more user-friendly (Column 2, lines 1-8).

Response to Arguments

9. Applicant's arguments with respect to claims 1-2, 4-10, 12-14, and 16-26 have been considered but are moot in view of the new ground(s) of rejection necessitated by amendment.

Applicant argues that claim 22 is statutory because of the wording "tangibly embodying", however Examiner still believes the claim is non-statutory because the specification does not define what is meant by "tangibly embodied"; the broadest

interpretation still includes transmission media, wireless links etc, which are non-statutory.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kim-Lynn Dam whose telephone number is (571) 270-1408. The examiner can normally be reached on M-TH 8:00-5:30, every other Friday 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Weilun Lo can be reached on (571) 272-4847. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Kim-Lynn Dam
/Ba Huynh/

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Primary Examiner, Art Unit 2179